

REMARKS

Applicant has amended the claims to cancel certain of the claims and conform with requirements of form, as discussed with the Examiner in the Interview of November 18, 2003, and set forth in the Office Action of August 18, 2003. For example, as set forth in greater detail below, Applicants have presented arguments requested regarding the appropriateness of combination of references with respect to certain features and have amended claims to include features of former claim 64.

I. Rejection under 35 USC §103

Claims 46-49, 52, 53, 55-58, 61, and 62 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,497,980 to Gorman et al. ("Gorman") in view of U.S. Pat. No. 2,561,950 to Shenk ("Shenk"). Claims 50, 51, 54, 59, 60, and 63 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,901,346 to Erving ("Erving") in view of Gorman and further in view of Shenk. Claims 64 and 65 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Gorman in view of Shenk further in view of U.S. Pat. No. 5,572,575 to Yamamoto et al. ("Yamamoto"). Applicants respectfully traverse these rejections. However, to expedite prosecution in the present application, features of former claim 64 have been included in each of the independent claims to better define the invention.

A. The Gorman, Shenk, and Yamamoto combination

Gorman discloses a voice controlled handsfree switching circuit for a telephone instrument. Placing a call in handsfree mode disables the handset and bypasses hookswitch access to the speech network (Col. 2, lines 8-11; Fig. 1; Fig. 4A). The handsfree mode for the present instrument is enabled in response to depression of a switch at the telephone instrument and is effective

regardless of the condition of the handset—on hook or off hook (Col. 2, lines 59-63; Fig. 1; Fig. 4A).

Shenk discloses an automatic telephone dial light attachment. The attachment includes a trip member that is actuated by the weight of a handset receiver, such that when the handset is picked up for dialing, a light comes on automatically (Col. 1, lines 23-30).

Yamamoto discloses a cordless phone system having a cordless handset and a speakerphone where the handset is active during the handsfree mode to allow communication between the handset audio input and output and the handsfree input and output (Col. 1, lines 53-57).

Amended claim 46 recites, "in response to the handset being removed from the handset-receiving portion during the telephone call, muting the audio input and maintaining to communicate the audio output of the telephone call via the hands-free audio interface and communicating a second audio input via the handset." The Gorman, Shenk, and Yamamoto references, either alone or in combination, do not disclose or suggest this claim element.

In combining these references, the Office Action contended that Gorman and Shenk render previous claim 46 obvious and that the addition of Yamamoto to this combination renders previous claim 64 obvious. Applicant respectfully asserts that the references may not properly be combined to render amended claim 46 obvious. Particularly, the Gorman, Shenk, and Yamamoto references lack a suggestion to combine with regard to the proposed modification and teach against combination with regard to the proposed modification (MPEP §2143.01 and §2145(X)). Further, the proposed modification of these references changes the principle of operation of one or more of the references, and the modification renders one or more references unsatisfactory for their intended purpose (MPEP §2143.01).

B. Teaching in Gorman regarding Communication of a Second Audio Input via the Handset

In the Gorman reference, closure of the HF ON button initiates the handsfree operation by setting the handsfree switch S31 and activating the handsfree switching network, completing the handsfree circuit paths and inactivating the handset path (Col. 7, lines 44-49; Fig. 3). Particularly, the handsfree switch directs the circuit to place a ground on the RELAY lead to operate RLY1 to switch the speech network to handsfree operation and **inactivate** the handset receiver and transmitter (Col. 4, lines 35-39; Fig. 2; Fig. 3). The relay is energized and closes contacts K1-K8 (Col. 7, lines 1-6; Figs. 4A, 4B, 4C). As this shows, in the handsfree mode of the Gorman device, the handset is completely inactive, without audio input or output. Conversely, amended claim 46 recites "communicating a second audio input via the handset" in response to removal of the handset during the handsfree telephone call, thus requiring activation of the handset during the handsfree mode.

Further, this is not merely an unintended consequence of the operation of the Gorman device. In at least four different locations in the written specification and at multiple locations in the drawings, Gorman teaches against any sort of handset activation during the handsfree mode of operation (e.g., Col. 2, lines 8-11; Col. 2, lines 59-63; Col. 4, lines 32-39; Col. 7, lines 42-49; Fig. 1, HK SW; Fig. 2, RLY1; Fig. 3, S31; Fig. 4A, HKSW). "The handsfree mode for the present instrument is enabled in response to depression of a switch at the telephone instrument and **is effective regardless of the condition of the handset**—on hook or off hook" (Col. 2, lines 59-63). "Placing the call in **the handsfree mode disables the handset [and] bypasses the hookswitch** access to the speech network" (Col. 2, lines 8-11). "This transistor [Q1] conducts and places a ground on the RELAY lead to operate relay RLY1 (Fig. 2) to switch the speech network to handsfree operation and to **inactivate the handset** receiver and transmitter" (Col. 4, lines 32-39). "From the foregoing it can be seen that **the position of the**

hookswitch—on hook or off hook—is of no consequence to the handsfree mode of operation" (Col. 7, lines 42-44).

This teaching against activation of the handset is not limited to a particular embodiment and is present throughout the Gorman invention. In fact, even in the use of an unrelated Gorman feature—four wire call announcing—the handset is also specifically taught as inactive (Col. 2, lines 64-68).

C. The References Teach Away from their Combination and from the Claimed Invention

"It is improper to combine references where the references teach away from their combination" (MPEP §2145(X)(D)(2)). As shown above, the Gorman reference teaches away from combination with any reference, including the Yamamoto reference, that provides handset activation during handsfree operation. As well, the Gorman reference teaches away from any claimed invention, such as that of amended claim 46, that provides handset activation during handsfree operation.

At the very least, there is no suggestion for combination of Gorman and Yamamoto or any other reference that provides handset activation during handsfree operation. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (MPEP §2143.01, emphasis in original). Therefore, for at least these reasons, Applicants respectfully request that the rejection to claim 46 be withdrawn.

D. The Proposed Modification Changes the Principle of Operation of At Least One of the References

"The proposed modification cannot change the principle of operation of a reference" (MPEP §2143.01). Applicants respectfully assert that the proposed modification changes the principle of operation of the Gorman reference. It is a

principle of operation of the Gorman reference to disable the handset when the phone is in handsfree mode. Accepting audio input from the base unit and the handset microphone simultaneously works directly against this principle of operation and is impossible for the Gorman device. Therefore, for at least these reasons, Applicants respectfully request that the rejection to claim 46 be withdrawn.

As to the Yamamoto reference, the Office Action notes that "Yamamoto discloses a speakerphone that accepts audio input simultaneously from the speakerphone base unit and the handset microphone" (Page 6). As the Office Action observes, a principle of operation of Yamamoto is accepting simultaneous input from a speakerphone base and cordless handset. However, amended claim 46 recites "in response to the handset being removed from the handset-receiving portion during the telephone call, muting the audio input...via the hands-free audio interface and communicating a second audio input via the handset." Since one of the principles of operation of Yamamoto is full communication between the handset and hands-free audio interface, muting the hands-free audio interface in response to the same event that prompts communicating by the handset would defeat this operational principle. Therefore, for the reason that the proposed modification changes the principle of operation of the Yamamoto reference, Applicants respectfully request that the rejection to claim 46 be withdrawn.

E. The Proposed Modification Renders the Cited References Unsatisfactory for their Intended Purposes

"If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed invention" (MPEP §2143.02). With respect to the Yamamoto reference, the proposed modification would act against a key

intended purpose—communication between a base speakerphone and a handset.

For instance, if one were using the handsfree mode on the base speakerphone and then wanted to activate the handset to communicate, Yamamoto would teach full activation of the handset and full activation of the base. It would make no sense to mute the base speakerphone over which Yamamoto wants to communicate, since this would render the speakerphone **unable** to communicate—merely listening to the party on the handset without being able to respond. Thus, since the proposed modification would render Yamamoto unsatisfactory for its intended purpose of communication, there is "no suggestion or motivation to make the proposed invention." Therefore, for at least these reasons, Applicants respectfully request that the rejection to claim 46 be withdrawn.

II. Remaining Claims

Claim 48 was amended to to recite "and communicate a second audio input via the handset." Claim 50 was amended to recite "and to communicate a second audio input via the handset." Claim 52 was amended to recite "and communicating a second audio input via the handset." Claim 53 was amended to recite "and communicate a second audio input via the handset." Claim 54 was amended to recite, "and communicate a second audio input via the handset." Claim 55 was amended to recite, "and communicating a second audio input via the handset." Claim 57 was amended to recite, "and communicate a second audio input via the handset." Claim 59 was amended to recite, "and to communicate a second audio input via the handset." Claim 61 was amended to recite, "and communicating a second audio input via the handset." Claim 62 was amended to recite, "and communicate a second audio input via the handset." And, claim 63 was amended to recite, "and communicate a second audio input via the handset."

Claims 47 and 65 depend from claim 46 and include all of the features of claim 46, plus additional features. Therefore, for at least the reasons discussed above with respect to claim 46, Applicants respectfully request that the rejection of claims 47 and 65 be withdrawn.

The Office Action rejected claims 48 and 55 for the same reasons it rejected claim 46. Therefore, for at least the reasons discussed above with respect to claim 46, Applicants respectfully request that the rejection of claims 48 and 55 be withdrawn.

The Office Action rejected claims 49, 52, 56, and 61 for the same reasons it rejected claim 47. Therefore, for at least the reasons discussed above with respect to claim 47, Applicants respectfully request that the rejection of claims 49, 52, 56, and 61 be withdrawn.

The Office Action rejected claim 57 for the same reasons it rejected claim 48. Therefore, for at least the reasons discussed above with respect to claim 48, Applicants respectfully request that the rejection of claim 57 be withdrawn.

The Office Action rejected claims 53, 58, and 62 for the same reasons it rejected claim 49. Therefore, for at least the reasons discussed above with respect to claim 49, Applicants respectfully request that the rejection of claims 53, 58, and 62 be withdrawn.

Claims 50, 51, 54, 59, 60, and 63 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,901,346 to Erving ("Erving") in view of Gorman and further in view of Shenk. Applicants respectfully traverse the rejection.

Neither Erving nor Gorman nor Shenk, alone or in combination, disclose or suggest "in response to the handset being removed from the handset-receiving portion during the telephone call, muting the audio input and maintaining to communicate the audio output of the telephone call via the hands-free audio interface and communicating a second audio input via the handset," which is recited in amended claim 46. The Office Action rejected claim 50 for the

same reasons it rejected previous claim 46, with the addition of the Erving reference to provide the computer-readable storage medium recited in claim 50. Erving is not cited for support in relation to the rejection of previous claim 46 and does not disclose or suggest, alone or in combination, "in response to the handset being removed from the handset-receiving portion during the telephone call, muting the audio input and maintaining to communicate the audio output of the telephone call via the hands-free audio interface and communicating a second audio input via the handset." Therefore, for at least the reasons discussed above with respect to claim 46, Applicants respectfully request that the rejection of claim 50 be withdrawn.

In addition, claim 51 depends from claim 50 and includes all of the features of claim 50, plus additional features. Therefore, for at least the reasons discussed above with respect to claim 50, Applicants respectfully request that the rejection of claim 51 be withdrawn.

The Office Action rejected claim 59 for the same reasons it rejected claim 50. Therefore, for at least the reasons discussed above with respect to claim 50, Applicants respectfully request that the rejection of claim 59 be withdrawn.

The Office Action rejected claims 54, 60, and 63 for the same reasons it rejected claim 51. Therefore, for at least the reasons discussed above with respect to claim 51, Applicants respectfully request that the rejection of claims 54, 60, and 63 be withdrawn.

III. Statement of Substance of the Interview

Applicants thank the Examiner for the courtesy of an interview and for his comments and suggestions on the further prosecution of this application. The interview took place on November 18, 2003, between the Examiner, Daniel Swerdlow, and the undersigned, Peter C. Breen, Reg. No. 47,441. The interview was via telephone, and no exhibits were shown or demonstrations conducted. The references discussed were U.S. Pat. No. 4,497,980 to Gorman et al., U.S. Pat.

No. 2,561,950 to Shenk ("Shenk"), and U.S. Pat. No. 5,572,575 to Yamamoto et al. All pending claims were discussed. The application of the references to the claims and the propriety of the combination of the references against the claims were discussed, but agreement was not reached with respect to the claims.

IV. Conclusion

Applicants thank the Examiner for withdrawing his objections to the drawings, for withdrawing his objections to informalities in the claims, and for providing the PTO-1449 form from the First Supplemental Information Disclosure Statement.

For all of the above reasons, Applicants respectfully request reconsideration and allowance of the present application. The Examiner is invited to contact the undersigned attorney at (312) 222-8101 if there are any outstanding issues that could be resolved through a telephone conference.

Respectfully submitted,



Peter C. Breen
Registration No. 47,441
Attorney for Applicants